


FEB 05 2007

TRANSMITTAL OF APPEAL BRIEF (Large Entity)					Docket No. US 010228	
In Re Application Of: Lalitha Agnihotri, et al.						
Application No. 09/866,823	Filing Date May 29, 2001	Examiner Justine E. Shepard	Customer No. 20987	Group Art Unit 2623	Confirmation No. 5093	
Invention: VIDEO PLAYBACK DEVICE CAPABLE OF SHARING RESOURCES AND METHOD OF OPERATION						
<u>COMMISSIONER FOR PATENTS:</u>						
Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on: <div style="text-align: center;">October 3, 2006</div>						
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William S. Francos, Esquire (Reg. No. 38,456) VOLENTINE FRANCOS & WHITT, P.L.L.C. One Freedom Square 11951 Freedom Drive, Suite 1260 Reston, VA 20190			<div style="border: 1px solid black; padding: 5px; margin-bottom: 5px;">I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on</div> <div style="border: 1px solid black; padding: 5px; margin-bottom: 5px;">(Date)</div> <div style="border: 1px solid black; padding: 5px; margin-bottom: 5px;">Signature of Person Mailing Correspondence</div> <div style="border: 1px solid black; padding: 5px;">Typed or Printed Name of Person Mailing Correspondence</div>			
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**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Appl. No: 09/866,823
Applicant(s): Lalitha Agnihotri, et al.
Filed: May 29, 2001
Title: Video Playback Device Capable of Sharing
Resources and Method of Operation
T.C./A.U.: 2600/2623
Examiner: Justine E. Shepard
Atty. Docket No. US 010228

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On: 05 February 2007

By:


Judith Riddell

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Honorable Assistant Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In connection with the Notice of Appeal dated October 3, 2006, Applicants provide the
following Appeal Brief in the above captioned application.

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TABLE OF CASES

1. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (CAFC 1983).
2. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994)
3. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).
4. Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).
5. Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

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1. Real Party in Interest

The real party in interest as assignee of the entire right and title to the invention described in the present application is Koninklijke Philips N.V. having a principle place of business at Groenewoudseweg 2, Eindhoven, The Netherlands.

2. Related Appeals and Interferences

There are no known related appeals or interferences at this time.

3. Status of the Claims

Claims 1-20 are pending in the present application. All have been finally rejected. The rejected claims 1-20 are duplicated in the Appendix.

4. Status of Amendments

A Final Office Action on the merits was mailed on June 13, 2006. A Reply to the Final Office Action was filed on August 13, 2006 traversing the rejections of the final Office Action. An Advisory Action dated September 6, 2006 was received. In response thereto, a Notice of Appeal was filed on October 3, 2006.

5. Summary of the Claimed Subject Matter¹

In one embodiment, a video playback device (e.g., 250) includes a disk storage device (e.g., 330) capable of storing television programs received from an external source; a first controller (e.g., 350) capable of receiving a first program recording command (e.g., 505), wherein said first program recording command is operable to cause said first controller to store a first television program on said disk storage device during a first time slot; and a

¹ In the description to follow, citations to various reference numerals, drawings and corresponding text in the specification are provided solely to comply with Patent Office Rules. It is emphasized that these reference numerals, drawings and text are representative in nature, and in not any way limiting of the true scope of the claims. It would therefore be improper to import any meaning into any of the claims simply on the

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second controller (e.g., 370) capable of determining if sufficient space is available on said disk storage device to store said first television program, wherein said disk storage device, in response to a determination that sufficient space is not available on said disk storage device is further capable of identifying in an external communication network (e.g., 115) a second remote video playback device capable of recording said first television program and transmitting a recording task request (e.g., 515) to said second remote video playback device, wherein said recording task request is operable to cause said second remote video playback device to record said first television program during said first time slot. (Kindly refer to claim 1; page 10, line 10 through page 17, line 16; page 20, line 19 through page 22, line 3; and Figs. 1-3 and 5 of the filed application.)

In another embodiment, a method of operating a video playback device comprising a disk storage device capable of storing television programs received from an external source includes: receiving a first program recording command, wherein the first program recording command is operable to cause the video playback device to store a first television program on the disk storage device during a first time slot; determining if sufficient space is available on the disk storage device to store the first television program (e.g., 505). Moreover, in response to a determination that sufficient space is not available on the disk storage device, the method includes identifying in an external communication network a second remote video playback device capable of recording the first television program (e.g., 510). In addition, the method includes transmitting a recording task request to the second remote video playback device, wherein the recording task request is operable to cause the second remote video playback device to record the first television program during the first time slot (e.g., 515, 520). (Kindly refer to claim 9; page 20, line 19 through page 22, line 3; and Figs. 1-3 and 5 of the filed application.).

In another embodiment, a server (e.g., 130) comprising a memory for storing a plurality

basis of illustrative language that is provided here only under obligation to satisfy Patent Office rules for maintaining an App

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of data files related to said plurality of video playback devices, wherein each of said plurality of data files (e.g., 401) comprises a disk status indicator indicating an amount of free space available on a disk drive in a selected one of said video playback devices. The server is adapted for use in a communication network (e.g., 115) coupled to a plurality of video playback devices. (Kindly refer to claim 1; page 17, line 17 through page 20, line 18; and Figs. 4A-4B).

6. Grounds of Rejection to be Reviewed on Appeal

The issues in the present matter are whether:

- I. Claims 17 and 18 are properly rejected under 35 U.S.C. § 102(e) in view of *Susskind* (US Patent Application Publication 2001/0046366);
- II. Claims 1 and 9 are properly rejected under 35 U.S.C. § 102(e) in view of *Utsunomiya, et al.* (US Patent Application Publication 2002/0066113);
- III. Claims 2, 3, 10 and 11 are properly rejected under 35 U.S.C. § 103(a) in view of *Utsunomiya, et al.* and *Potrebic*; and
- IV. Claims 4-8 and 12-16 are properly rejected under 35 U.S.C. § 103(a) in view of *Utsunomiya, et al.*, *Potrebic* and *Susskind*.

7. Argument

In this portion of the Appeal Brief, arguments are provided. Notably, because no claims have been amended or allowed, Applicants maintain previous arguments for patentability provided in response to Office Actions.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g.*,

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W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

I. Rejection under 35 U.S.C. § 102(e) of claims 17 and 18 in view of *Susskind* (US 2001/0046366 A1).

Claim 17 is drawn to a server for use in a communication network coupled to a plurality of video playback devices. The server comprises a memory for storing a plurality of data files related to a plurality of video playback devices. Each of the plurality of data files comprises a disk status indicator indicating an amount of free space available on a disk drive in a selected one of said video playback devices.

a. *Susskind* fails to disclose the server as claimed

In the Final Office Action, the Examiner relies, inter alia, on paragraphs [0029] and [0035]. As noted in the response thereto, the **VRD** referred to in pgs. [0016] and [0029] of *Susskind* is capable to communicate with a server.

In the Advisory Action, the Examiner asserts: "Upon reading the claim, it is clear that the limitation of the claim is a server connected to a VRD for the purpose of storing files

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related to the VRD. Susskind discloses a server connected to a VRD for tracking the amount of free space remaining on the VRD.” Applicants respectfully disagree.

First of all, Applicants reiterate that claim 17 unequivocally recites “...a server comprising a memory for storing a plurality of data files related to said plurality of video playback devices...” This is not anticipated by the VRD of *Susskind* which is not a server, but rather only adapted to communicate with the server. Stated differently, Applicants have specifically claimed a server, not a device capable of communicating with a server. Thus, the reference fails to disclose **at least one element** of claim 17, and because anticipation requires that **each and every element** of the claimed invention be embodied in a single prior art device or practice, a prima facie case of anticipation cannot be made based on the reference to *Susskind*.

Furthermore, the statement from the Advisory Action quoted above conflict with a statement on page 2 of the Final Office Action. To wit, the Examiner states: “These statements show that the VRD acts as a server containing recorded shows for users to access.” Thus, according to this assertion, the **VRD acts as the server**; but in the rebuttal to Applicants Response under Rule 116, the Advisory Action alleges that **VRD and server are two different components**. Accordingly, clarification as to the Examiner’s position is respectfully requested.

In anticipation of this clarification, Applicants have rebutted each position through the present Appeal Brief, or previous Responses, or both.

b. *Susskind* fails to disclose the server with the memory as claimed

In the Final Office Action, the Examiner relies on paragraphs [0029] and [0035] in the assertion that the reference discloses a server with memory.

Claim 17 also features that the server includes “...a **memory** for storing a plurality of data files related to said plurality of video playback devices...” In an embodiment described

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in connection with Fig. 4A, each VDP data file 401-403 includes a disk statistics table that indicates the amount of space that is used and the amount of space that is free for recording programs. Thus, within the resource sharing server 130, each of the VDP data files 401-403 store disk drive space available.

By contrast, the **VRD** disclosed in paragraph [0029] of *Susskind* includes a common computer hard disk rather than video tape as a means of storage. As such, *Susskind* discloses: a VRD with memory, wherein the VRD is capable of communicating with a server. Moreover, the portion of *Susskind* relied upon in the Office Action (pgh. [0035], lines 16-17) describes a web access device that is adapted to run an HTML web browser pointed to the URL of the host 23. The HTML pages provide all the interface components required to operate a video recording device 20. The essential functions of the video recording device 20 are presented in HTML pages include minutes of storage available. This function is supplied by the internet remote control host server 24.

However, there is no description of a server having memory and including a plurality of data files, and that each data file indicates an amount of free space available on a disk drive. In fact, it is not clear from the noted portion of *Susskind* how the minutes of storage available for the video recording device 20 are maintained, or that this relates to a disc drive as opposed to another type of permanent memory device.

For at least the reasons set forth above, Applicants respectfully submit that the reference to *Susskind* fails to disclose at least the server that comprises the memory as recited in claim 17. Therefore, it is respectfully submitted that because at least one element of claim 17 is not disclosed in the portion of the reference relied upon by the Examiner; a prima facie case of anticipation has not been established.

For at least the reasons set forth above, it is respectfully submitted that the rejection of claim 17 is improper and should be withdrawn. Moreover, by similar reasoning, it is

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respectfully submitted that the rejection of claims 18-20 which depend immediately or ultimately from claim 17 is also improper and should be withdrawn.

II. Rejection of claims 1 and 9 under 35 U.S.C. § 102(e) in view of *Utsunomiya, et al.* (US 2002/0066113 A1)

Claim 1 is drawn to a video playback device, comprising:

“...**a first controller** capable of receiving a first program recording command, wherein said first program recording command is operable to cause said first controller to store a first television program on said disk storage device during a first time slot; and

a second controller capable of determining if sufficient space is available on said disk storage device to store said first television program, wherein said disk storage device....”

Plainly, the video playback device includes two controllers, each performing a particular function. Claim 9 is drawn to a method and includes a similar feature.

The portion of the Office Action reproduced above relies on recorders/players 3 and 4 for the first and second controllers of the video playback device of claim 1. Fig. 6 of *Utsunomiya, et al.* shows a block diagram illustrating a configuration of the playing system of **recorder/player 3 or 4**. Fig. 6 reveals that the each of the player/recorders 3, 4 include a **single control unit 10**, and **not a first controller and a second controller** as claimed.

In the Advisory Action, the Examiner asserts: “As the recorders/players (figure 1, parts 3 and 4) are not located in the same box, the applicant argues that they each represent a single controller and therefore does [sic] not meet the limitations in claim 1. The claim does not contain the limitation of ‘contained in the same unit’ and thus will not be read into the claims.” Applicants respectfully but strongly disagree with the Examiner’s rationale.

As noted, the video playback device 250 of an embodiment shown in Figs. 2 and 4A contain first and second controllers (i.e., two controllers). By contrast, the recorders/players 3, 4 of the applied reference include but one controller. The examiner cobbles the present

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rejection by culling two controllers from two devices, with each **device** having **only one controller**. Thus, according to the Examiner's rationale, it is wholly proper to select components from two separate devices in order to anticipate a claim in which one device has two components. Applicants respectfully submit that this is wholly improper. To this end, by the Examiner's reasoning, if prior to the invention of a twin-engine plane, one were to have invented a plane with two engines, two single-engine planes would be properly combinable to anticipate a claim to the twin-engine plane. Clearly this is wholly improper. Moreover, and continuing along this analogy, the applicant would have to claim an airplane having a first motor and a second motor contained within the same airplane. There is no basis provided by the Examiner that this would be required.

For at least the reasons set forth, Applicants respectfully submit that the reference to Utsumomiya, *et al.* fails to disclose at least the video playback device having the first controller and the second controller as claimed. Therefore, it is respectfully submitted that because at least one element of claims 1 and 9 are not disclosed in the portion of the reference relied upon by the Examiner, a prima facie case of anticipation has not been established.

For at least the reasons set forth above, it is respectfully submitted that the rejection of claims 1 and is improper and should be withdrawn. Moreover, by similar reasoning, it is respectfully submitted that the rejection of claims 2-8 and 10-16, which depend immediately or ultimately from claims 1 and 9, respectively, are also improper and should be withdrawn.

III. Rejections under 35 U.S.C. § 103(a) of claim 2-8, 11-16 and 18-20

Claims 2-8, 11-16 and 18-20 depend from claims 1, 9 and 17, respectively. For at least the reasons set forth above, those independent claims are patentable over the applied art. Therefore, claims 2-8, 11-16 and 18-20 that depend therefrom are patentable at least for the reasons set forth above. By no means do Applicants concede the propriety of these rejections.

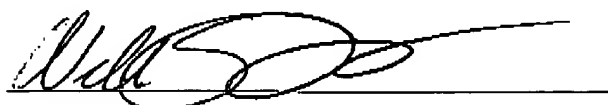
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8. Conclusion

In view of the foregoing, applicant(s) respectfully request(s): the withdrawal of all objections and rejections of record; the allowance of all the pending claims; and the holding of the application in condition for allowance.

Respectfully submitted on behalf of:

Koninklijke Philips N.V.



by: William S. Francos, Esq. (Reg. No. 38,456)

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Appendix
Claims on Appeal

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Claims on Appeal:

1. A video playback device comprising:
a disk storage device capable of storing television programs received from an external source;
a first controller capable of receiving a first program recording command, wherein said first program recording command is operable to cause said first controller to store a first television program on said disk storage device during a first time slot; and
a second controller capable of determining if sufficient space is available on said disk storage device to store said first television program, wherein said disk storage device, in response to a determination that sufficient space is not available on said disk storage device is further capable of identifying in an external communication network a second remote video playback device capable of recording said first television program and transmitting a recording task request to said second remote video playback device, wherein said recording task request is operable to cause said second remote video playback device to record said first television program during said first time slot.
2. The video playback device as set forth in Claim 1 wherein said second controller is further capable of comparing said first program recording command to a second program recording command previously received by said first controller and determining if a second time slot associated with said second program recording command overlaps said first time slot.
3. The video playback device as set forth in Claim 2 wherein said second controller, in response to a determination that said first and second time slots overlap, is further capable of accessing said second remote video playback device via said external communication network

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and transmitting said recording task request to said second remote video playback device, wherein said recording task request is operable to cause said second remote video playback device to record said first television program during said first time slot.

4. The video playback device as set forth in Claim 3 further comprising a memory for storing said first and second program recording commands in a recording schedule table.

5. The video playback device as set forth in Claim 3 wherein said second controller identifies said second remote video playback device by accessing a central server in said external communication network and requesting from said central server a list of remote video playback devices capable of recording said first television program.

6. The video playback device as set forth in Claim 5 wherein said second controller is capable of transmitting to said central server disk space status information regarding an amount of available space on said disk storage device.

7. The video playback device as set forth in Claim 6 wherein said second controller is further capable of transmitting to said central server a program recording schedule regarding television programs scheduled to be recorded by said video playback device.

8. The video playback device as set forth in Claim 7 wherein said second controller is further capable of receiving from a third video playback device an incoming recording task request, wherein said incoming recording task request is operable to cause said video playback device to record a requested television program associated with said incoming recording task request.

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9. A method of operating a video playback device comprising a disk storage device capable of storing television programs received from an external source, the method comprising the steps of:

receiving a first program recording command, wherein the first program recording command is operable to cause the video playback device to store a first television program on the disk storage device during a first time slot;

determining if sufficient space is available on the disk storage device to store the first television program;

in response to a determination that sufficient space is not available on the disk storage device, identifying in an external communication network a second remote video playback device capable of recording the first television program; and

transmitting a recording task request to the second remote video playback device, wherein the recording task request is operable to cause the second remote video playback device to record the first television program during the first time slot.

10. The method as set forth in Claim 9 comprising the further steps of:

comparing the first program recording command to a second program recording command previously received by the first controller; and

determining if a second time slot associated with the second program recording command overlaps the first time slot.

11. The method as set forth in Claim 10 comprising the further steps of:

in response to a determination that the first and second time slots overlap, accessing the second remote video playback device via the external communication network; and

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transmitting the recording task request to the second remote video playback device, wherein the recording task request is operable to cause the second remote video playback device to record the first television program during the first time slot.

12. The method as set forth in Claim 11 wherein the disk storage device stores the first and second program recording commands in a recording schedule table.

13. The method as set forth in Claim 11 wherein the step of identifying the second remote video playback device comprises the sub-steps of:

accessing a central server in the external communication network; and
requesting from the central server a list of remote video playback devices capable of recording the first television program.

14. The method as set forth in Claim 13 further comprising the steps of:
transmitting to the central server disk space status information regarding an amount of available space on the disk storage device.

15. The method as set forth in Claim 14 further comprising the steps of transmitting to the central server a program recording schedule regarding television programs scheduled to be recorded by the video playback device.

16. The method as set forth in Claim 15 further comprising the steps of:
receiving from a third video playback device an incoming recording task request, wherein the incoming recording task request is operable to cause the video playback device to record a requested television program associated with the incoming recording task request.

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17. For use in a communication network coupled to a plurality of video playback devices, a server comprising a memory for storing a plurality of data files related to said plurality of video playback devices, wherein each of said plurality of data files comprises a disk status indicator indicating an amount of free space available on a disk drive in a selected one of said video playback devices.

18. The server as set forth in Claim 17 wherein each of said plurality of data files further comprises a recording schedule table indicating a list of television programs scheduled to be recorded by said selected one of said video playback devices.

19. The server as set forth in Claim 18 wherein said server is capable of receiving from a first one of said video playback devices a recording task request associated with a first television program, wherein said server, in response to receipt of said recording task request determines a second one of said video playback devices capable of recording said first television program.

20. The server as set forth in Claim 19 wherein said server transmits to said first video playback device a network address associated with said second video playback device.

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Appendix
Evidence (None)

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Appendix
Related Proceedings (None)

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